

Attorney Docket No. P63215US1
Application No. 09/774,641

REMARKS

Claims 5 and 6 are amended to address the rejection of the claims under 35 USC 112, second paragraph, for allegedly being indefinite by reciting "may sometimes contain." The phrase at issue is deleted from the claims by the instant Amendment.

Claim 2 was rejected under 35 USC 102(b) based on alleged admissions of prior art in the specification paragraph bridging pages 6 and 7. In addition to the reasons previously provided, reconsideration is requested in view of the following remarks.

The paragraph bridging pages 6 and 7 of the present specification (the "paragraph at issue") discusses the prior art "vertical type closed tube method" exemplified in the published (1996) summary of a presentation by Kikushige Ono at the Joint Symposium of 63rd Convezazione for Studying Microanalysis ("Ono1996"). Ono1996, in fact, is concerned with "Automation of analyses of halogen and sulfur by IC"; and, as an example, it describes a process in which a sample, converted to a capsule by a backing of thin Japanese paper on Parafilm, is allowed to drop from the top of a vertical, closed combustion tube. According to Ono1996, the vaporized Parafilm acts as a combustion assistant and, as a result of forced-vapor-phase mixing by a spiral current of oxygen, heat-decomposition of the sample at high-temperature is realized and, thus, efficiency of heat-decomposition is increased. Therefore, consistent with the description of Ono1996 given in the instant specification, Ono1996 teaches that the presence of a combustion assistant is critical to the desired result.

The alleged "admission of prior art" set forth in the statement of rejection paraphrases what is actually written about Ono1996 in the paragraph at issue and does so in a manner that inaccurately reflects what is *described*. According to the statement of rejection (Office Action, page 4):

The method of Ono, as admitted by Applicants [sic] . . . disclose[s] a sample which is dropped into the top of a vertical closed combustion tube heated in a furnace

....

On the other hand, according to the paragraph at issue (*emphasis added*),

[a] sample wrapped in *combustion assistant* is dropped from the top of [a] vertical closed combustion tube heated in [a] furnace . . .

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Accordingly, the statement of rejection mischaracterizes what is "admitted by Applicant[]," in that the rejection omits "combustion assistant" from its version. Moreover, this omission is not a harmless error.

The present specification expressly distinguishes the prior art on the basis of the "combustion assistant" feature, essential in Ono1996. According to the present specification (paragraph bridging pages 7 and 8), Applicant's "inventive appliance . . . requires *no combustion assistant*" (*emphasis added*). Even without using a combustion assistant, sufficient pretreatment of the sample is provided in accordance with the presently claimed invention; and, furthermore, there is no problem of polluting the measuring system as a result of using the combustion assistant. Thus the presently claimed invention makes it possible to perform accurate quantitative analysis of testing components. By failing to attribute the combustion assistant as an essential feature of the "admitted" prior art, the rejection incorrectly finds anticipation under §102(b).

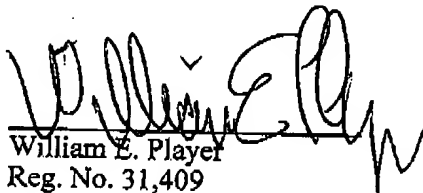
WEP
in
the
amendment

Favorable action is requested.

Respectfully submitted,

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Marked Up Version of Amendments

IN THE CLAIMS

Rewrite the claims as follows.

6 (twice amended). A pretreatment method of a sample using the device of claim 5, comprising the steps of setting up the sample which may sometimes contain organics together with oxygen in the heat-decomposing appliance closing, and then heating said heat-decomposing appliance with the device to decompose the organics ~~which may be sometimes contained in said sample.~~

8 (twice amended). A pretreatment method of a sample using the device of claim 7, comprising the steps of setting up the sample which may sometimes contain organics together with oxygen in the heat-decomposing appliance and closing, then heating said heat-decomposing appliance with said heating means to decompose the organics ~~which may be sometimes contained in said sample,~~ thereby producing the testing components, cooling said heat-decomposing appliance, injecting the absorbing liquid into said heat-decomposing appliance to dissolve the testing components, and further stirring and/or shaking said heat-decomposing appliance to make said absorbed liquid in the heat-decomposing appliance uniform.